APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,960	04/17/2000	Richard C. Levine	065581.0105	1648

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EXAMINER
WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)	
Office Action Summary		09/550,960	LEVINE, RICHARD C.	
		Examin r	Art Unit	
		Richard Woo	3629	

-- The MAILING DATE of this communication appears on th cover sh et with the correspond nce addr ss --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _01 May 2003_ .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-154_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-154_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _3_ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Response to Arguments

1)   The amendment, filed May 01, 2003, is acknowledged.

2)   Applicant's arguments, filed May 01, 2003, with respect to the last office action

have been carefully considered.

Section 101 Rejections

In response to Applicant's argument that produce a useful, concrete, and tangible

result and directed to various methods of routing an object in a transportation network

that include a number of limitations, the examiner respectfully traverses the argument

for the reasons as follows:

- Although the Applicant submits that the invention is directed to various methods

of routing an object in a transportation network, only the preamble of the claim merely

recites this limitation and the features upon which applicant relies are not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Notwithstanding a statement of intended use carries some patentable weight in a

method claim, the claimed invention lacks patentable utility because there is not

technological step involved in the claimed invention. The invention merely describes

'routing an object" or delivering the object (e.g. mail or parcel) in association with a

corresponding address and code, which could be possibly done with a conventional

delivery system (a manual activity can accomplish the same delivery or routing result):

Ex parte Bowman, 61 USPQ 2d 1669 (BdPatApp&Int 2001).

The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must
> focus on whether the claimed subject matter...is
> statutory, not on whether the product of the claimed
> subject matter...is statutory, not on whether the
> prior art which the claimed subject matter purports to
> replace...is statutory, and not on whether the claimed
> subject matter is presently perceived to be an
> improvement over the prior art, e.g., whether it
> "enhances" the operation of a machine. *In re Toma* at
> 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

In the instant application the claimed invention is not within the technological arts – i.e., **no computer implementation or any other technology employed.**

Election Requirement

Applicant's argument that the examiner's election requirement is unnecessary is persuasive and the requirement is hereby withdrawn.

Section 102 Rejections

Applicant's argument regarding rejections as being anticipated by Cordery et al.

and Gravell et al. are carefully considered and deemed to be persuasive.

3)   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Claim Rejections - 35 USC § 101

4)   Claims 77-127 are rejected under 35 U.S.C. 101 because the claimed invention

lacks patentable utility. *See* the reasons as recited earlier in the response to

arguments.

Claim Rejections - 35 USC § 112

5)   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6)   Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

In Claim 20, line 2, the recitation of "another functional property code" renders

the claim indefinite because it is not clear whether this refers to the second functional

property code or a totally new functional property code.

Claim Rejections - 35 USC § 103

7)   Claims 1-154 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Furman (US 5,465,295) in view of Whitehouse (US 5,341,505).

<u>W.R.T. Claims 1, 39, 77, 101 and 128</u>:

Furman discloses a method and apparatus for routing an object in a

transportation network, comprising:

a first point (S1 in Fig. 1) operable to obtain and send a first address (e.g. the

phone number of S2, a second point) and a first functional property code (e.g. if it is a

fax, then F#; for voice mail, then VM#; and for e-mail, the code is "EM") associated with

an object (e.g. fax, voice mail message, e-mail etc.) to a database (e.g. 250 in Fig. 2);

a processor coupled to the database and to the first point, the processor

operable to:

store a second functional property code, a second address (the general

phone number of S2), and a third address (fax, voice mail, **electronic mail**) associated

with a second point (S2) (see Fig.2);

receive the first address and the first functional property code from the first

point (see Fig.1);

determine if the first address is compatible with the second address (see

Fig. 2 and col. 4, lines 16-30 for example);

determine if the first functional code is compatible with the second

functional property code (see Figs. 2-4 and col. 4, lines 16-30 for example); and

send the message from the first point to the destination point if the codes

are compatible with each other.

However, Furman does not expressly disclose the invention including:

the third address being sent to the first point if the first code is compatible with

the second code.

Whitehouse teaches, for a system and method for routing an object in a

transportation network, that the system and method comprises:

a first point (1 in Fig. 4) operable to obtain and send a first address (see Fig. 5)

associated with an object (mail or parcel) to a database (6, 10, 18);

the database coupled to the first point, the database operable to:

store a second address (the destination address), and a third address

(ZIP+4 for the destination address) associated with a second point (destination as

queried by the first point user) (see col. 7, lines 33-68);

receive the first address from the first point (see Fig.4);

determine if the first address is compatible with the second address (see

col. 7, lines 33-68); and

send the third address to the first point if the addresses are compatible

with each other (see col. 7, lines 33-68).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Furman such that the system's third address includes the postal zip code and the system sends the third address or Zip+4 to the first point if the first code is compatible with the second code, as taught by Whitehouse, for the purpose of providing quick, easy and low-cost Zip+4 lookup (telecommunications-based) and subsequent POSNET barcode printing for small and medium volume routing or mailing operations.

W.R.T. Claims 2-6, 10-11, 15-17, 40-44, 48-49, 53-55, 78-80, 82, 88-89, 102, 106-109, 129 and 133-136:

Furman individually or in combination with Whitehouse discloses the method including routing the object to the second point (destination point) based on the third address.

The modified Furman discloses printing the barcode on the envelope and other mailing object and it would have been obvious to one skilled in the art to print the barcode on the label and attach it to the object.

The modified Furman also discloses the method of retrieving the object from the second point based on the third address (Furman discloses that user may retrieve the e-mail or fax from the destination point based on the third address).

The modified Furman discloses that the second address comprises a partial postal address (Whitehouse teaches of using the postal address as depicted in Figs. 5-6).

W.R.T. Claims 7-9, 45-47, 86-87, 103-105 and 130-132:

The modified Furman discloses the invention as recited earlier but does not

expressly disclose the invention including:

the second address matching the third address;

the first address comprising part of the second address; and

the third address comprising a pseudo-address.

At the time the invention was made, it would have been an obvious matter of

design choice to a person of ordinary skill in the art to modify the invention such that the

second address matches the third address; the first address includes part of the second

address; and the third address includes a pseudo-address because Applicant has not

disclosed that the above cited limitations provides an advantage, is used for a particular

purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would

have expected Applicant's invention to perform equally well with the matching address;

the compatibility of the first and second addresses; and third address being a barcode

containing ZIP+4 because the modified Furman can route the objects with its own

address and code matching system.

Therefore, it would have been an obvious matter of design choice to modify

Furman and Whitehouse to obtain the invention as specified in claims 7-9, 45-47, 86-87,

103-105 and 130-132.

W.R.T. Claims 12-14, 18, 21-23, 28-32, 38, 50-52, 56, 59-60, 66-71, 76, 81, 83-

85, 90, 93, 95-96, 100, 110-112, 117-122, 127, 137-139, 144-149 and 154:

The modified Furman discloses the invention as recited earlier and includes:

the database being co-located with the first point (as depicted in Fig. Fig. 4 of

Whitehouse);

the database being remote from the first point (as depicted in Fig. 1 of Furman);

the database comprising a processor and a memory (every computer includes

these);

storing the first functional property code at the first point (as shown in Fig. 4 of

Whitehouse);

sending a no match code from the database to the first point if the first address

(or code) is not compatible with the second one (both Furman and Whitehouse

discloses the step of send the no-match code if incompatible);

the database storing a second functional property code, a second address, and a

third address for each of a plurality of second points (see Fig. 1 of Furman and Fig. 4 of

Whitehouse);

sending a no match code to the first point if the first address is incompatible with

any or all of the second addresses;

storing at least one additional functional property code for the second point (see

Fig. 2 of Furman);

the first functional property code being compatible with the second one if the first

functional property code is compatible with at least one of the second codes;

the transportation network is a parcel or mail delivery network (as taught by

Whitehouse);

routing comprising selecting a network node to which to route the object (as

taught by Whitehouse in Fig. 4 showing LAN or WAN for routing across the network

nodes);

a keyboard (see Figs. from both Furman and Whitehouse for the keyboard); and

a graphical user interface (see specifically Figs. 5-6 for GUI).

W.R.T. Claims 19-20, 24-27, 33-37, 57, 61-65, 72-75, 91-92, 94, 97-99, 113-116,

123-126, 140-143 and 150-153:

The modified Furman discloses the invention as recited earlier

modifying the first functional property code before sending by substituting

another code for the first code;

determining whether the first code is compatible with the third code if the first

code is incompatible with the second one;

sending a no match code from the database to the first point if the first code is

not compatible with the second and third codes;

selecting between the third address and the fourth address if the first code is

compatible with the second and third codes;

selecting the address associated with whichever of the second code and the third

code matches the first code;

sending a not match code from the data base to the first point if the first code is

incompatible with all of the second codes;

the second code comprising a negated functional property code, whereby the

first code is incompatible with the second one if the first code is compatible with the

negated code;

the second code at least comprising a mandatory functional property code;

obtaining and sending at least additional functional property code associated with

the first address (the first address has multiple functional property codes);

the first code being compatible with the second code if each of the first codes is

compatible with at least one of the second codes; and

generating the functional property code based on automated optical recognition

of the object.

At the time the invention was made, it would have been an obvious matter of

design choice to a person of ordinary skill in the art to modify the invention such that the

original point functional property code and the destination point functional property

code(s) must be compared for the compatibility in various ways, as claimed by the

Applicant (i.e. third address, fourth address, multiple codes, negated, mandatory, etc.)

and generating the code based on the optical recognition of the object (e.g. barcode)

because Applicant has not disclosed that the above cited various means of determining

compatibility between the original and destination functional property codes and means

for obtaining the code provide an advantage, are used for a particular purpose, or solve

a stated problem. One of ordinary skill in the art, furthermore, would have expected

Applicant's invention to perform equally well with the modified Furman because the

modified Furman can determine whether the original point functional code(s) is

compatible with the destination point functional property code(s); obtain the information

via the GUI; and show that the OCR can obtain the information with respect to the

object so as to generate the functional property code instead of obtaining the

information via GUI.

Therefore, it would have been an obvious matter of design choice to modify

Furman and Whitehouse to obtain the invention as specified in claims 19-20, 24-27, 33-

37, 57, 61-65, 72-75, 91-92, 94, 97-99, 113-116, 123-126, 140-143 and 150-153.

Conclusion

8)   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

US 6,076,121 is cited to show a system and method of addressing and

translating addresses in a network. The system and method apply to transportation

networks such as airlines, busses, rail, and shipping to pipeline networks such as the oil
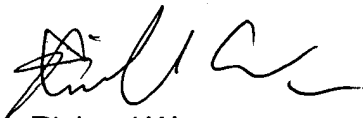
industry, delivery networks such as postal services, and to other networks in which

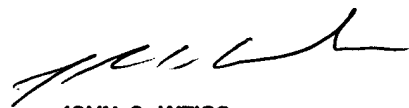symbolic addresses are used to designate a source and a destination of traffic.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Richard Woo whose telephone number is 703-308-

7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00

PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-305-7687 for

regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-308-

0861.

Richard Woo
Patent Examiner
GAU 3629
August 18, 2003

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600